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Message

In re the Application of:

Sundeep BHAN et al.

Application No.: 10/734,811

Filed: December 11, 2003

For: TARGETED INVITATION DELIVERY

Group Art Unit: 3629

Examiner: Ouellette, Jonathan P.

APPEAL BRIEF

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/734,611
Filing Date	December 11, 2003
First Named Inventor	Sundeep BHAN et al
Art Unit	3629
Examiner Name	Ouellette, Jonathan P.

Total Number of Pages In This Submission	18	
Attorney Docket Number		49298-043

ENCLOSURES   *(Check all that apply)*

- [✓] Fee Transmittal Form
  - [✓] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53

- [ ] Drawing(s)
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- [ ] Appeal Communication to Board of Appeals and Interferences
- [✓] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [ ] Other Enclosure(s) (please identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	PROSKAUER ROSE LLP		
Signature	*[signature]*		
Printed name	Robert S. Mayer		
Date	March 10, 2006	Reg. No.	38,544

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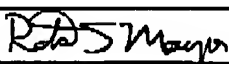| Signature	*[signature]*		
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	Complete If Known	
Effective on 12/08/2004. *Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).* # FEE TRANSMITTAL ## For FY 2005	Application Number	10/734,811
	Filing Date	December 11, 2003
	First Named Inventor	Sundeep BHAN
	Examiner Name	Jonathan P. OUELLETTE
☒ Applicant claims small entity status. See 37 CFR 1.27	Art Unit	3629
TOTAL AMOUNT OF PAYMENT ($)250.00	Attorney Docket No.	49298-043

METHOD OF PAYMENT (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	Small Entity Fee ($)	SEARCH FEES Fee ($)	Small Entity Fee ($)	EXAMINATION FEES Fee ($)	Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims		Extra Claims	Fee ($)	Fee Paid ($)	Multiple Dependent Claims	
	- 20 or HP =	x	=		Fee ($)	Fee Paid ($)

HP = highest number of total claims paid for, if greater than 20

Indep. Claims		Extra Claims	Fee ($)	Fee Paid ($)
	- 3 or HP =	x	=	

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
- 100 =	/ 50 =	(round up to a whole number) x	=	

4. OTHER FEE(S)

Fee Paid ($)

Non-English Specification, $130 fee (no small entity discount) ____

Other: Appeal Brief = 250.00 ____ 250.00

SUBMITTED BY

Signature	[signature]	Registration No. (Attorney/Agent) 38,544	Telephone (212) 969-3246
Name (Print/Type)	Robert S. Mayer		Date March 10, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application No. 10/734,811
Attorney Docket: 49298-043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Examiner: Ouellette, Jonathan P.

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Applicants respectfully ask the Board to reverse the final rejection under 35 U.S.C. § 102 of claims 1-6, 8, 10-15, 17, and 18 in the above-identified application.

This paper is believed timely because the time period for filing an Appeal Brief was reset by the Notice of Panel Decision from Pre-Appeal Brief Review mailed February 13, 2006. The Commissioner is authorized to charge any fees required in connection with this paper, including but not limited to the fee required by 37 C.F.R. § 41.20(b)(2), to Deposit Account No. 16-2500.

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Real Party in Interest

The real party in interest is Medsite, Inc., a New York corporation, and the assignee of

record.

Related Appeals and Interferences

There are no related Appeals or Interferences.

Status of Claims

Claims 1-6, 8, 10-15, 17, and 18 are pending. All those claims stand rejected under 35

U.S.C. § 102 and are the subject of this appeal. Claims 7, 9, and 16 were previously cancelled.

Claims 1, 6, and 15 are independent.

Status of Amendments

Applicant's Amendment After Final Rejection dated November 10, 2005, was not

entered. Accordingly, the claims from the Amendment dated June 8, 2005 are the ones that

remain under consideration. Those claims are reproduced below in the Claims Appendix.

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Summary of Claimed Subject Matter

The claimed subject matter relates generally to delivering invitations to people in situations where there are multiple events and multiple potential invitees. The invitees are matched up with the events based on (a) who the event sponsors want to invite and/or (b) what events the invitees have expressed an interest in. In a preferred embodiment described in the last sentence of paragraph 33 in the specification, all the matched-up invitations are formatted into an email that is delivered to the invitee. An example of such an email is depicted in FIG. 6, where the invitee is being invited to two events.

More specifically, claim 1 relates to a four-step method of selectively distributing invitations for a plurality of events. The first step is to store event information about each of a plurality of events, where the event information includes at least one criterion for selecting invitees. (See paragraphs 16, 18, and 19 in the specification, reference no. 12 in FIG. 1, and all of FIG. 2.) The second step is to store member information about each of a plurality of members. (See paragraphs 17 and 20 in the specification, reference no. 13 in FIG. 1, and all of FIG 3.) The third step is to detect, for each of the members, whether the invitee-selection criterion for each of the events matches the member information. (See paragraphs 21-27 in the specification and reference no. 14 in FIG. 1.) The fourth step is to send an e-mail invitation to members for whom a match was detected, where the e-mail invitation invites its recipient to events for which a match was detected, and where at least one of the e-mail invitations invites its recipient to a plurality of events. (See paragraphs 32-34 in the specification, reference no. 16 in FIG. 1, and all of FIG. 6.)

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Claim 6 relates to a related four-step method of selectively distributing invitations for a plurality of events. The first step is to store event information about each of a plurality of events, where the event information includes at least one criterion for selecting invitees. (See paragraphs 16, 18, and 19 in the specification, reference no. 12 in FIG. 1, and all of FIG. 2.) The second step is to store member information about each of a plurality of members, where the member information includes member preferences. (See paragraphs 17, 20, and 25 in the specification, reference no. 13 in FIG. 1, and all of FIG 3.) The third step is to determine, based on matches between the member information and the invitee selection criterion and between the event information and the member preferences, which events each member should be invited to. (See paragraphs 21-27 in the specification and reference no. 14 in FIG. 1.) The fourth step is to send invitations via email to the members based on results of the third step, where at least one of the invitations invites its recipient to more than one of the events. (See paragraphs 32-34 in the specification, reference no. 16 in FIG. 1, and all of FIG. 6.)

Claim 15 is a Beauregard type claim that corresponds to claim 6, discussed above.

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Grounds of Rejection to Be Reviewed on Appeal

Whether claims 1, 6, and 15 are unpatentable under 35 U.S.C. § 102(b) over WO

01/52106 A2 *(Gal)*.

Argument

All pending claims stand rejected under 35 U.S.C. § 102 as anticipated by WO 01/52106

A2 (*Gal*). Applicant respectfully submits that the rejections under 35 U.S.C. § 102 of

independent claims 1, 6, and 15 are improper, and asks the Board to reverse those rejections. All

three independent claims (claims 1, 6, and 15) are being argued together as a group because their

rejections are believed improper for the same reasons.

Claims 1, 6, and 15

Claim 1, which is representative of the group, is directed to a method of selectively

distributing invitations for a plurality of events, and the last step recited in that claim reads as

follows:

> sending an e-mail invitation to at least some of the members for
> whom a match was detected in the detecting step, wherein the e-mail
> invitation invites its recipient to at least some of the events for which
> a match was detected in the detecting step, and wherein at least one of
> the e-mail invitations sent in the sending step invites its recipient to a
> plurality of events for which a match was detected in the detecting
> steps.

To satisfy the underlined portions of this claim, at least one of the invitations must (a)

invite its recipient to a plurality of events (in other words, it must be a multi-event invitation) and

(b) be sent via email.

The applicant recognizes that *Gal* describes a multi-event invitation at p. 5, lines 15-20

and in FIG. 4. However, that portion of *Gal* does not teach or suggest sending the multi-event

invitation via email. To the contrary, *Gal* specifies that the invitation "is dynamically

constructed" "when a user goes to the web page for the user's invitations." *Gal* at p. 5, lines 18-

20.

Gal then goes on to explain that the invitations should <u>not</u> be generated via email as

follows: "The advantage of [generating] the message with the dynamically created web page

rather than a traditional E-mail type message is that the messages are not considered as intrusive

[and] don't clog up the recipient's work or home E-mail system." *Gal* at p. 6, lines 1-6. Since

Gal explains that email should <u>not</u> be used to serve the multi-event invitations, and claim 1

explicitly recites that the invitations are set via email, <u>*Gal* teaches away from the method of</u>

<u>claim 1</u>.[1]

Despite the fact that *Gal* describes a "dynamically constructed" invitation, and despite the

explicit teaching in *Gal* that email should <u>not</u> be used for the invitations, the Final Office Action

asserted that *Gal* satisfied the "email" limitation in claims 1, 6, and 15. This rejection was based

on a definition from www.dictionary.com that defines email as "electronic communication

through a computer." (Final Office Action dated August 15, 2005, at p. 5, ¶15.)

Applicant submits that the Examiner has misused the dictionary.com definition upon

which he relies. The dictionary.com definition cannot be construed as an indication that the

scope of the term "email" and the scope of the phrase "electronic communication through a

computer" are the same, since that construction is flatly contradicted by the existence of many

types of "electronic communication through a computer" that are not emails (e.g., HTML web

pages served by a web server, VOIP telephone calls, instant messages, computer access via

---

[1] Applicant recognizes that *Gal* does mention sending a message via email at page 3, line 15.
However, *Gal's* mention of this email message is made in connection with a different
embodiment, and *Gal* contains no teaching or suggestion that this email message is a multi-event
invitation. Because claim 1 requires that "at least one of the <u>e-mail invitations</u> sent in the
sending step <u>invites its recipient to a plurality of events</u>," claim 1 is not satisfied by sending <u>any</u>
message via email. It is only satisfied when <u>a multi-event invitation</u> is sent via email, which is
not disclosed in *Gal*. Claim 1 is therefore believed patentable over *Gal*.

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remote terminals, etc.). Rather, the only plausible reading of the dictionary.com definition that is

consistent with the plain meaning and common understanding of the word "email" is that email

is a specific type of "electronic communication through a computer." In other words, email is a

narrow species within the broader genus of "electronic communication through a computer."

See M.P.E.P. § 2111.01 ("The words of a claim must be given their 'plain meaning' unless they

are defined in the specification").

Of course, there are also many other types "of electronic communication through a

computer" besides email, one of which is the "dynamically generated web pages" that are

described in *Gal.* Since the Examiner relied on one species within the broad genus of electronic

communications to reject a different species within that same broad genus, the rejection can be

analogized to relying on a dictionary that defines an automobile as "a vehicle" to justify use of a

reference that discloses a bicycle in rejecting a claim that recites an automobile. This is clearly

improper, since "to anticipate a claim, the reference must teach every element of the claim."

M.P.E.P. § 2131. "A claim is anticipated only if each and every element as set forth in the claim

is found, either expressly or inherently described, in a single prior art reference. *Id.* That

requirement has not been satisfied here since the *Gal* reference relied on by the Examiner does

not disclose sending the multi-event invitation via email, a limitation that is explicitly recited in

claim 1. Applicant therefore submits that claim 1 is patentable over *Gal.*

Independent claims 6 and 15 each include limitations that require at least one of the

invitations to (a) invite its recipient to a plurality of events and (b) be sent via email. More

specifically, the last step in claim 6 is:

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PAGE 11/19 * RCVD AT 3/10/2006 1:00:25 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/12 * DNIS:2738300 * CSID: * DURATION (mm-ss):03-54

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> sending invitations to the members based on results of the determining step, wherein the invitations are sent via email and at least one of the invitations invites its recipient to more than one of the events.

And the last step in claim 15 is:

> sending email invitations to the members based on results of the determining step, wherein at least one of the invitations invites its recipient to more than one of the events.

Claims 6 and 15 are therefore believed patentable for the same reasons explained above in connection with claim 1.

In view of the foregoing amendments and remarks, Applicant respectfully asks the Board to reverse the outstanding rejections. Applicant's undersigned attorney may be reached by telephone at (212) 969-3246 or by facsimile at (212) 969-2900. Please continue to direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP

Date: March 10, 2006   By: _____
                                      Robert S. Mayer
                                      Attorney for Applicants
                                      Registration No. 38,544

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Claims Appendix

1.   (original) A method of selectively distributing invitations for a plurality of events, the

method comprising the steps of:

storing event information about each of a plurality of events, wherein the event

information for each of the plurality of events includes at least one invitee selection criterion;

storing member information about each of a plurality of members;

detecting, for each of the plurality of members, whether the at least one invitee selection

criterion for each of the events matches the member information; and

sending an e-mail invitation to at least some of the members for whom a match was

detected in the detecting step, wherein the e-mail invitation invites its recipient to at least some

of the events for which a match was detected in the detecting step, and

wherein at least one of the e-mail invitations sent in the sending step invites its recipient

to a plurality of events for which a match was detected in the detecting steps.

2.   (original) The method of claim 1, wherein the at least one invitee selection criterion

comprises an area of practice.

3.   (original) The method of claim 1, wherein the at least one invitee selection criterion for

each of the plurality of events is selected by a sponsor of the respective event.

4.   (original) The method of claim 1, wherein the at least one invitee selection criterion

comprises an identifier that uniquely identifies an individual member.

5.   (original) The method of claim 1, wherein the at least one invitee selection criterion

comprises a list of identifiers, each of which uniquely identifies an individual member.

6.   (previously presented) A method of selectively distributing invitations for a plurality of

events, the method comprising the steps of:

        storing event information about each of a plurality of events, wherein the event

information for each of the plurality of events includes at least one invitee selection criterion;

        storing member information about each of a plurality of members, wherein the member

information for each of the plurality of members includes at least one member preference;

        determining, based on (a) matches between the member information and the at least one

invitee selection criterion for each of the plurality of events and (b) matches between the event

information and the at least one member preference for the respective members, which events

each of the plurality of members should be invited to; and

        sending invitations to the members based on results of the determining step, wherein the

invitations are sent via email and at least one of the invitations invites its recipient to more than

one of the events.

7.   (canceled)

8.   (previously presented) The method of claim 6, wherein, in the determining step, a

decision to invite a given member to a given event requires (a) a match between the member

information for the given member and the at least one invitee selection criterion for the given

event and (b) a match between the event information for the given event and the member preference for the given member.

9.   (canceled)

10.   (original) The method of claim 6, wherein, in the determining step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member.

11.   (original) The method of claim 6, wherein the at least one invitee selection criterion comprises an area of practice.

12.   (original) The method of claim 6, wherein the at least one invitee selection criterion for each of the plurality of events is selected by a sponsor of the respective event.

13.   (original) The method of claim 6, wherein the at least one invitee selection criterion comprises an identifier that uniquely identifies an individual member.

14.   (original) The method of claim 6, wherein the at least one invitee selection criterion comprises a list of identifiers, each of which uniquely identifies an individual member.

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15.   (previously presented) A computer-readable medium upon which executable instructions
are stored, wherein the instructions instruct a computer to facilitate the selective distribution of
invitations by performing the steps of:

storing event information about each of a plurality of events, wherein the event
information for each of the plurality of events includes at least one invitee selection criterion;

storing member information about each of a plurality of members, wherein the member
information for each of the plurality of members includes at least one member preference;

determining, based on (a) matches between the member information and the at least one
invitee selection criterion for each of the plurality of events and (b) matches between the event
information and the at least one member preference for the respective members, which events
each of the plurality of members should be invited to; and

sending email invitations to the members based on results of the determining step,
wherein at least one of the invitations invites its recipient to more than one of the events.

16.   (canceled)

17.   (original) The method of claim 16, wherein, in the determining step, a decision to invite
a given member to a given event requires (a) a match between the member information for the
given member and the at least one invitee selection criterion for the given event and (b) a match
between the event information for the given event and the member preference for the given
member.

18.   (original) The method of claim 15, wherein, in the determining step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member.

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Evidence Appendix

-- none --

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Related Proceedings Appendix

– none –